



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Cornell, et al. Docket No.: ROC920000228US1
Serial No.: 09/749,108 Group Art Unit: 2171
Filed: 12/27/00 Examiner: NGUYEN, CINDY
For: APPARATUS AND METHOD FOR HINDERING MULTIPLE HTTP SUBMISSION
REQUESTS

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APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This appeal is taken from the Examiner's final rejection, set forth in the Office Action dated 02/3/04, and affirmed in the Advisory Action dated 06/03/04, of applicants' claims 1-6. Applicants' Notice of Appeal under 37 C.F.R. § 1.191 was mailed on 05/03/04.

REAL PARTY IN INTEREST

International Business Machines Corporation is the Real Party in Interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for this patent application.

STATUS OF CLAIMS

As filed, this case included claims 1-6. The claims as originally filed have not been amended. In the final rejection, claims 1-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,473,738 to Garrett in view of U.S. Patent No. 6,128,651 to Cezar. No claim was allowed. Claim 1-6 as originally filed are currently pending.

STATUS OF AMENDMENTS

The claims as originally filed have not been amended. As a result, the claims at issue in this case are claims 1-6 as originally filed.

SUMMARY OF INVENTION

According to the preferred embodiments, an apparatus and method inhibit multiple submission requests by placing an intermediate web page between the page where the user submits information and the following page. After a preset period of time viewing the intermediate page, the user is redirected automatically to the following page. If a user then presses "Reload" or "Refresh" on their browser, the submission of information is not duplicated, thereby hindering multiple submission requests.

ISSUE

The following single issue is presented for review on this Appeal:

1. **Whether claims 1-6 are unpatentable under 35 U.S.C. §103 over Garrett in view of Cezar**

GROUPING OF CLAIMS

Claims 1-6 are grouped, and stand and fall together based on claim 1.

ARGUMENT

**Issue 1: Whether claims 1-6 are unpatentable under 35 U.S.C. §103
 over Garrett in view of Cezar**

Claim 1

The Examiner rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Garrett in view of Cezar. In the rejection of claims 1 and 4, the Examiner states that Garrett discloses a first web page that includes a form into which a user may enter information, citing col. 9 lines 4-27 of Garrett. The Examiner states that Garrett discloses an intermediate web page at col. 10 line 54 to col. 11 line 5. The Examiner states that Garrett discloses a next web page at col. 10 lines 18-39. The Examiner admits that Garrett does not disclose rendering the intermediate page for a predetermined period of time, and then automatically rendering the next web page when the predetermined period of time expires. The Examiner cites to Cezar as disclosing rendering a web page for a predetermined period of time, and then automatically rendering the next web page when the predetermined period of time expires, citing col. 7, lines 22-40 of Cezar. The Examiner then states:

Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include period of time expires in the system of Garrett, as taught by Cezar. The motivation being to enable displayed and timed advertisements under the control of system.

Applicants respectfully submit that the combination of Garrett and Cezar suggested by the Examiner would not have been obvious to one of ordinary skill in the art, that the Examiner's stated rationale for combining Garrett and Cezar is defective, that the only possible rationale for combining Garrett and Cezar as suggested by the Examiner is through the use of impermissible hindsight reconstruction, and that the combination of

Garrett and Cezar, even if proper, does not teach the limitations in the claims. Each of these arguments is addressed in turn below.

Combination of Garrett and Cezar Suggested by the Examiner Would Not Have Been Obvious to One of Ordinary Skill in the Art

Applicants respectfully assert that the combination of Garrett and Cezar suggested by the Examiner would not have been obvious to one of ordinary skill in the art. Cezar deals with the rendering of advertisements in a web browser while a person is browsing. In Cezar, once a user makes an initial browser request to a client webserver (step 30 in FIG. 2), a frame set (24 in FIG. 1) is loaded, and advertisements 16 are then displayed in the frame set. Each advertisement includes a timer that determines how long the advertisement is displayed. When a timer times out, the next advertisement in the frame set is selected and displayed. Note that the rendering of advertisements in the frame set in Cezar occurs without any user control or intervention. Once the user makes an initial request to a client webserver (step 30 in FIG. 2), a first advertisement is automatically displayed in the frame set, and when the timer for the first advertisement times out, a different ad is automatically displayed in the frame set. Display of ads continues as long as the user is browsing the same client webserver, without any interaction or control by the user. Automatic timed rendering of ads without user intervention is a fundamental principle in on-line advertising. If the advertising were only presented at the user's request, the coverage of an advertizer's ad would be substantially reduced, and advertising would not have its desired effect. Thus, a fundamental principle of online advertising is that it generally occurs without user intervention or control, as specifically taught by Cezar.

Garrett teaches the use of a form to submit information to a web server to complete a purchase transaction. The user fills out the form and decides when to submit the form to the web server. A user controls when information in a form is submitted, so

Garrett operates under user control. Because the timed rendering of advertisements in Cezar occurs with no user control, it would not have been obvious to one of ordinary skill in the art to combine the form in Garrett with the timed rendering of ads in Cezar to arrive at the claimed invention.

The Examiner's Stated Rationale for Combining Garrett and Cezar Is Defective

Applicants respectfully assert that the Examiner's stated rationale for combining Garrett and Cezar is defective. The Examiner's stated rationale for the combination of Garrett and Cezar is:

Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include period of time expires in the system of Garrett, as taught by Cezar. The motivation being to enable displayed and timed advertisements under the control of system.

According to the Examiner, it apparently would have been obvious for one of ordinary skill in the art to display a web page in Garrett for a predetermined period of time as taught by Cezar so Garrett could display timed advertisements. This rationale, however, is not consistent with the Examiner's mapping of the claim limitations to Garrett and Cezar. The Examiner maps the display 1200 in FIG. 12 of Garrett on the intermediate page in the claims. To be consistent with this mapping, the Examiner would have to assert that one of ordinary skill in the art would be motivated to display the display 1200 in Garrett for a predetermined period of time based on the teachings of Cezar. The Examiner has made no such statement or showing. The Examiner's stated motivation for combining Garrett and Cezar is defective because the stated rationale is not consistent with the Examiner's mapping of the claim limitations to Garrett and Cezar. As a result, the Examiner has failed to establish a prima facie case of obviousness for claims 1-6 under 35 U.S.C. §103(a) based on the combination of Garrett and Cezar.

The Only Possible Rationale for Combining Garrett and Cezar as Suggested by the Examiner Is Through the Use of Impermissible Hindsight Reconstruction

Applicants respectfully assert that the only possible rationale for combining Garrett and Cezar as suggested by the Examiner is through the use of impermissible hindsight reconstruction. The Federal Circuit has held:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)(quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

Applicants respectfully assert that there is no teaching or suggestion in either Garrett or Cezar that supports the Examiner's combination. The only possible motivation for the combination comes from applicants' claims, which amounts to impermissible hindsight reconstruction by the Examiner. The Federal Circuit has also held:

In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1793 (Fed. Cir. 1988)(quoting Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1832 (Fed. Cir. 1987)).

Applicants recognize that Garrett and Cezar both teach certain limitations in the claims. This is not the end of the inquiry. As stated above, the relevant inquiry is whether the prior art made obvious the invention as a whole for which patentability is claimed. Applicants state at p. 12 lines 1-7 of the specification:

The concept of redirection is known in the art, and is commonly used for directing an HTTP request for a web page to the location of a

different web page if the requested web page is no longer available. Redirection with a delay as discussed herein is also known. However, **redirection as a result of submitting a form to a web server is not known in the art**, and is the subject of the present invention. By redirecting the user to an intermediate page, then to a next page after a short delay, the likelihood of inadvertently submitting the form information to the web server multiple times decreases.

As stated above, redirection *as a result of submitting a form to a web server* is not known in the art. Neither Garrett nor Cezar teach such redirection. The timed rendering of advertisements in Cezar does not read on the timed rendering of an intermediate page in response to a user submitting information in a form to a web server, as recited in the claims.

The Combination of Garrett and Cezar, even if proper, does not teach all of the limitations in the claims

Claim 1 recites:

. . . wherein the web server application renders the first web page to a browser for the user to enter the information, and when the user submits the entered information to the web server application, the web server application receives the entered information, renders the intermediate page for a predetermined period of time, and then automatically renders the next web page when the predetermined period of time expires.

We see from this clause in claim 1 that the web server application performs several functions: 1) renders the first web page to a browser for the user to enter the information; 2) when the user submits the entered information to the web server application the web server application performs the following three tasks: 2A) receives the entered information; 2B) renders the intermediate page for a predetermined period of time; 2C) then automatically renders the next web page when the predetermined period of time expires.

In the rejection of claims 1 and 4, the Examiner states that Garrett discloses a first web page that includes a form into which a user may enter information, citing col. 9 lines 4-27 of Garrett. The Examiner states that Garrett discloses an intermediate web page at col. 10 line 54 to col. 11 line 5. The Examiner states that Garrett discloses a next web page at col. 10 lines 18-39.

According to the Examiner's rejection, the intermediate web page is taught by Garrett at col. 10 line 54 to col. 11 line 5. This cited language refers to display 1200 in FIG. 12. For the combination of Garrett and Cezar to read on claims 1 and 4, it would have to be obvious based on the teachings of Cezar regarding the display of timed advertisements to display the display 1200 for a predetermined period of time, followed by rendering the next web page when the predetermined period of time expires. Note, however, that Garrett expressly teaches away from rendering display 1200 for a predetermined period of time followed by rendering a next web page. Display 1200 in FIG. 12 includes buttons 103, 104, 105, 106, 107 and 1210 that may be clicked by the user to perform a desired function. The display 1200 is displayed until the user clicks on a button that causes a different page to be displayed. The steps in box 1202 in FIG. 12 show the steps in purchasing an item using the Garrett system. Step 1 is to provide the purchaser's credit card information. Step 2 is to verify the purchaser's shipping information and party 1's shipping information. Step 3 requires the user to click on button 1210 to complete the purchase. Display 1200 thus requires action by a user (such as clicking on button 1210 or on one of buttons 103-107) to display a next web page. Claim 1, in contrast, recites that the intermediate web page is rendered for a predetermined period of time, followed by the rendering of the next web page when the predetermined period of time expires. If display 1200 were rendered as the intermediate page in claim 1, the predetermined period of time could expire before the user completes all of steps 1-3, causing the system in Garrett to not function correctly. Garrett thus expressly teaches away from the timed rendering of display 1200. Even if the predetermined period of time were sufficient for a user to perform steps 1-3, the

limitations in claim 1 would require the user to wait until the predetermined period of time expires before rendering the next web page. If this were the case, clicking on the Place Order button 1210 would not cause the next web page to be displayed, because the predetermined time period would have to expire before the next web page could be displayed. As a result, the user would waste time waiting for the predetermined period of time to expire even though the user is ready to proceed based on the user clicking the Place Order button 1210. Garrett teaches displaying web pages based on user interaction. There is no teaching or suggestion in Garrett for employing a timer for a web page, and such a timer would interfere with providing the web pages in Garrett in a timely manner to the user.

The Examiner's stated rationale for combining Garrett and Cezar seems to ignore the Examiner's own mapping of claim limitations. The Examiner seems to say that it would be obvious based on the teachings of Cezar to render timed advertisements in the system of Garrett. This, however, misses the point. The page rendered for a predetermined period of time in the claims is the *intermediate page*, which, according to the Examiner, is display 1200 in FIG. 12 of Garrett. Because the Examiner's stated rationale for combining Garrett and Cezar is inconsistent with the mapping of claim limitations to Garrett and Cezar, the Examiner has failed to establish a prima facie case of obviousness for claims 1 and 4 under 35 U.S.C. §103(a).

The web server application in Garrett renders a page with a form to a user to enter information, which the user submits to the web server application. However, claim 1 specifically recites, *when the user submits the entered information to the web server application*, the web server application performs steps 2A), 2B) and 2C) listed above. There is no support in Garrett, Cezar or their combination to perform the steps of rendering the intermediate page (display 1200 in FIG. 12) for a predetermined period of time, then automatically rendering the next web page when the predetermined period of time expires *in response to the user submitting information to a web server*. To the

contrary, the steps of rendering timed advertisement web pages in Cezar are performed without the user entering information to a web server. Because the combination of Cezar and Garrett do not include a web server application that performs all of steps 2A), 2B) and 2C) above when the user submits the entered information to the web server, claim 1 is allowable over the combination of Cezar and Garrett.

In the Response to Arguments section of the final office action, the Examiner states:

Applicant is responsibility for the four corners of the reference. Clearly the first paragraph of the summary in Cezar (as well as the cited passages) clearly teaches showing a page for a predetermined period of time. Garrett was not relied on this teaching. It is true that 1200, fig. 12 does not automatically shift to the next page, but the function is the teaching of Cezar. Clearly, the page shown in fig. 12 is an intermediate page.

The phrase “Applicant is responsibility for the four corners of the reference”, in addition to being very poor English, does not make any sense. To which reference is the Examiner referring? Are the applicants somehow responsible for the content of Garrett or Cezar? This position would be ludicrous. Of course, applicants are responsible for the content of the pending patent application, but it is totally unclear how this relates to the pending rejection of the claims.

Let’s analyze carefully the last two sentences of the Examiner’s language: “It is true that 1200, fig. 12 does not automatically shift to the next page, but the function is the teaching of Cezar. Clearly, the page shown in fig. 12 is an intermediate page.” In the first of these two sentences, the Examiner admits that the display 1200 in fig. 12 of Garrett does not automatically shift to the next page, but attempts to justify the rejection by stating that he automatic shifting to the next page is the teaching of Cezar, not Garrett. In the second of these two sentences, the Examiner states “Clearly, the page shown in fig. 12 is an intermediate page.” Applicants forcefully assert that clearly, the page shown in

fig. 12 of Garret **IS NOT** an intermediate page. The term “intermediate page” is defined in claim 1 as a web page that is rendered for a predetermined period of time in response to the user entering information into the form in the first web page, and submitting the information in the form to a web server. The display 1200 in fig. 12 of Garrett is rendered in response to the user entering information into web page 700 of FIG. 7. However, the display 1200 in fig. 12 is rendered until the user clicks on one of the buttons 103-107 or 1210 on the web page. The Examiner seems to believe that it would be obvious to render display 1200 to the user for a predetermined period of time based on the teachings of Cezar. This position, however, ignores the fundamental difference between an advertisement web page shown and described in Cezar and an interactive user web page shown as display 1200 in fig. 12 of Garrett.

The real issue in this appeal, to boil it down to a very simple question, is this: would one of ordinary skill in the art be motivated to render the display 1200 in fig. 12 of Garrett for a predetermined period of time (as taught in Cezar) followed by the next web page in Garrett? The Examiner says Yes. Applicants forcefully and emphatically say NO, for the many reasons given above, and for the additional reasons that follow.

Advertisement web page are typically rendered on a timed basis. If the user likes the advertisement and clicks on a link in the advertisement web page, the timer loop is broken and control is passed to the advertiser’s web site, which then displays one or more web pages to the user that allow the user to interactively surf the advertiser’s web site. A fundamental aspect of advertisement web pages is that the time rendering of these advertisements only continues as long as the user does not click on any link in an advertisement web page. Clicking on a link in an advertisement web page automatically shifts modes from timed rendering of ads to interactive rendering of web pages based on user input. By clicking on an advertisement, the user has indicated he or she wants more information about an advertised product or service, so the very act of clicking serves to turn off the timer that was rendering the ads. This shows conclusively that the timed

rendering of a web page when a browser is in an interactive mode expecting user input (as indicated by the buttons 103-107 and 1210 on display 1200) would not have been obvious to one of ordinary skill in the art.

The display 1200 in fig. 12 of Garrett is not rendered on a timed basis. Of course, the Examiner's position is that this feature is taught in Cezar. It appears that the Examiner is treating the prior art as a smorgasbord, picking and choosing the teachings she likes without regard to the other express teachings in the reference. Would one of ordinary skill in the art be motivated to show display 1200 in fig. 12 of Garrett "for a predetermined period of time" followed by the rendering of a next web page? A quick look at the web page itself answers that question, as discussed in detail above. If display 1200 in fig. 12 of Garrett were displayed for a predetermined period of time, as suggested by the Examiner, the navigation buttons 103-107 and 1210 would have to be rendered inactive. Is there any teaching or suggestion in Garrett or in the combination of Garrett and Cezar to inactivate user interface buttons? Of course not. The detailed discussion above regarding the interactive nature of display 1200 is offered to very simply show that one of ordinary skill in the art would not be motivated to render page 1200 on a timed basis based on the teachings of Cezar. To the contrary, one of ordinary skill in the art will recognize that the display 1200 in fig. 12 of Garrett must be rendered until the user clicks on an appropriate button 103-107 or 1210. To render the next page before the user clicks on one of these buttons, or to render the next page at some predetermined time in the future (without regard to when the user clicked on the button) would present a user interface that would be very frustrating, if not impossible, to use. The Examiner can't map display 1200 on the intermediate page in the claims without stating or showing why one of ordinary skill in the art would be motivated to render display 1200 only for a predetermined period of time without waiting for the user input that display 1200 expressly expects. This position effectively asserts that it would be obvious to render the buttons 103-107 and 1210 in display 1200 inactive so the page is rendered for a predetermined period of time, instead of being rendered until the user clicks on one of

those buttons. To say that display 1200 is clearly an intermediate page belies the express teachings of Garrett. The Examiner, when stating that display 1200 is an intermediate page, cannot ignore the features of display 1200 that make it unsuitable for use as an intermediate page. As explained in great detail above, the fact that display 1200 is an interactive web page with buttons the user clicks to proceed to the next page expressly teaches away from rendering display 1200 for a predetermined period of time, followed by the next web page, as recited in the claims.

The rendering of an intermediate web page as recited in claim 1 is a significant advance in the art because it prevents resubmission of form information by a user repeatedly clicking on a submit button. This problem is evident in the USPTO's own web site. Attached as Exhibit A is a copy of a web page rendered by the USPTO web site. Note that sensitive information has been redacted to protect confidential information. Near the bottom of this web page are three buttons, Submit, Change and Cancel. Just above these three buttons the web page states:

**Note - Pressing 'Submit' multiple times may cause multiple transactions.
Pressing 'Cancel' after pressing 'Submit' will not cancel the transaction.**

The PTO's own web site suffers from the problem that the claimed invention solves. By introducing an intermediate web page for a predetermined period of time, the page that includes the 'Submit' button is no longer present, thus preventing the user from generating multiple transactions inadvertently by pressing 'Submit' multiple times. If the claimed invention truly were obvious under 35 U.S.C. §103(a), as asserted by the Examiner, one of ordinary skill in the art would have applied the teachings of Garrett and Cezar to solve this huge problem on the USPTO web site. Yet this problem remains. And this problem exists on NUMEROUS other web sites. This is external evidence that the combination of Garrett and Cezar as suggested by the Examiner would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants respectfully assert that the Examiner has not considered these claims as a whole. The rendering of timed advertisements without user interaction does not read on the rendering of an intermediate page for a predetermined time period followed by a next web page. Such a system avoids multiple submissions by the user. The Examiner has now made two attempts to combine Garrett and Cezar in different ways to arrive at the claimed invention. Both attempts have been unsuccessful.

For the many reasons given above, applicants respectfully assert that claim 1 is allowable over the combination of Cezar and Garrett, and respectfully request that the Examiner's rejection of claim 1 under 35 U.S.C. §103(a) be reversed.

Claims 2-6

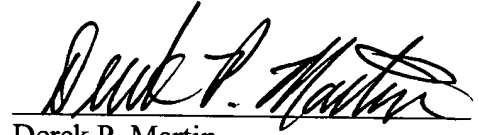
Claims 2-6 are grouped with claim 1, and stand or fall according to the allowability of claim 1.

CONCLUSION

Claims 1-6 are addressed in this Appeal. For the numerous reasons articulated above, applicants maintain that the rejection of claims 1-6 under 35 U.S.C. § 103(a) is erroneous.

Applicants respectfully submit that this Appeal Brief fully responds to, and successfully contravenes, every ground of rejection and respectfully requests that the final rejection be reversed and that all claims in the subject patent application be found allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Derek P. Martin", written over a horizontal line.

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APPENDIX - CLAIMS FINALLY REJECTED

- 1 1. An apparatus comprising:
2 at least one processor;
3 a memory coupled to the at least one processor;
4 a web server application residing in the memory and executed by the at least one
5 processor, the web server application rendering specified web pages to web browsers at
6 the web browsers' request;
7 a first web page residing in the memory that includes a form into which a user may
8 enter information and a mechanism for the user to submit the entered information to the
9 web server application;
10 an intermediate web page residing in the memory;
11 a next web page residing in the memory;
12 wherein the web server application renders the first web page to a browser for the
13 user to enter the information, and when the user submits the entered information to the
14 web server application, the web server application receives the entered information,
15 renders the intermediate page for a predetermined period of time, and then automatically
16 renders the next web page when the predetermined period of time expires.
- 1 2. The apparatus of claim 1 wherein if the user reloads the next web page the entered
2 information is not re-submitted to the web server application.
- 1 3. The apparatus of claim 1 wherein the intermediate web page specifies the
2 predetermined period of time.

- 1 4. A method for a web server to render web pages to a user, the method comprising the
2 steps of:
- 3 (A) rendering to a user a first web page that includes a form into which the user may
4 enter information and a mechanism for the user to submit the entered information to the
5 web server;
- 6 (B) when the user submits the entered information to the web server, the web server
7 performs the steps of:
- 8 (B1) receiving the entered information;
- 9 (B2) rendering an intermediate web page for a predetermined period of
10 time; and
- 11 (B3) automatically rendering a next web page when the predetermined
12 period of time expires.
- 1 5. The method of claim 4 further comprising the step of not resubmitting the entered
2 information when the user clicks on a reload or refresh button in a web browser that is
3 displaying the next web page.
- 1 6. The method of claim 4 wherein the intermediate web page specifies the
2 predetermined period of time.



Please confirm that the information shown below is correct. If there are any errors, click **"Change"** to return to the previous form. Otherwise, click **"Submit"** to process payment, or **"Cancel"** to abort the transaction.

Credit Card Payment Information:

Card Number:	
Card Type:	MASTERCARD
Name on Card:	DEREK P. MARTIN
Expiration Date:	
Street Address 1:	P.O. BOX 548
Street Address 2:	
City:	CARTHAGE
State:	MISSOURI
Zip Code:	64836-0548
Country:	USA
Amount:	\$510.00
Description:	MAINTENANCE FEE PAYMENT

Attorney Docket Number: Optional

Your transaction may take up to 90 seconds.
We appreciate your patience.

Note - Pressing 'Submit' multiple times may cause multiple transactions.
Pressing 'Cancel' after pressing 'Submit' will not cancel the transaction.

Exhibit A